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In re Application of
MEDERSKI, et al.
U.S. Application No.: 10/089,166
PCT No.: PCT/EP00/08940
Int. Filing Date: 13 September 2000
Priority Date: 28 September 1999
Attorney's Docket No.: MERCK 2033A
For: QUINAZOLINONES

PETITION UNDER

37 CFR 1.182

This decision is in response to applicant's declaration filed by facsimile 02 January 2003 in the United States Patent and Trademark Office (USPTO). The filing of the declaration is being treated as a petition under 37 CFR 1.182 as detailed below.

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BACKGROUND

On 13 September 2000 applicant filed international application PCT/EP00/08940, which claimed priority of an earlier application filed 28 September 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 April 2001. A Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 March 2002.

On 27 March 2002, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an English translation of the international application.

On 25 June 2002, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 06 August 2002, applicant filed a declaration accompanied by the appropriate surcharge for providing an oath or declaration of the inventors later than thirty months from the

priority date.

On 02 January 2003, applicant filed the present declaration executed by Maria Devant as executor and legal representative of deceased inventor Ralf Devant.

On 28 January 2003, applicant was mailed a decision dismissing applicant's request for status under 37 CFR 1.42 and notifying applicant that the filed declaration was not in compliance with 37 CFR 1.497.

DISCUSSION

It is noted that the papers filed 02 January 2003 reference U.S. serial number 10/089,167; however, the attorney reference number and PCT international application number listed on the declaration match application 10/089,166 and reference George Dombroske, the legal examiner handling application 10/089,166. The 28 January 2003 dated decision was mailed before the present papers could be matched with the file. As such, the declaration is being treated as a petition under 37 CFR 1.182 to direct the papers to application 10/089,166. As authorized, the \$130.00 petition fee will be deducted from Deposit Account No.: 13-3402. The declaration is being treated as a request for status under 37 CFR 1.42. An examination of the filed declaration shows that applicant has now provided an executed declaration signed by the legal representative detailing the citizenship of both the deceased inventor and the legal representative. Thus, it is proper to grant applicant's renewed request for status under 37 CFR 1.42 at this time. It is noted that applicant is still required to submit a compliant declaration which satisfies the defects pointed out in the decision mailed 28 January 2003.

CONCLUSION

Applicant's petition under 37 CFR 1.182 to transfer the subject declaration to application number 10/089,166 is **GRANTED**.

Applicant's request for status under 37 CFR 1.42 is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for further processing and forwarding to the appropriate group art unit for examination. The declaration filed 02 January 2003 will be placed in application number 10/089,166. All responses regarding filing a compliant declaration curing the previously detailed defects should reference serial number 10/089,166.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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